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Art Unit 3637

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE



Applicant: ROBERT D. VANDERMINDEN

Serial No: 09/895,950

Filed: June 29, 2001

Title : UMBRELLA TILT MECHANISM

Customer No.: 27162

Commissioner for Patents
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APPEAL BRIEF

Sir:

This is an appeal from the Final Rejection dated December 22, 2004 of claims 1, 3 to 9 and 11 to 14.

This Appeal Brief is being filed in triplicate to replace the defective Appeal Brief filed March 4, 2005.

A check in the amount of \$250.00 (small entity) was previously submitted on March 4, 2005. Should any additional fees be required, please charge such to Deposit Account 03-0678.



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REAL PARTY IN INTEREST

The real party in interest is the assignee of record, Telescope Casual Furniture Inc. of Granville, New York.

RELATED APPEALS

There are no related appeals and/or interferences.

STATUS OF CLAIMS

Claims 1, 3 to 9 and 11 to 14 have been rejected.

Claims 15 and 17 to 24 have been allowed.

STATUS OF AMENDMENTS

A Request for Reconsideration of the Final Rejection has not been entered pursuant to an Advisory Action dated February 7, 2005.

SUMMARY OF CLAIMED SUBJECT MATTER

Independent Claim 1

The claimed subject matter of independent claim 1 is a tilt mechanism for an umbrella that is comprised of a pair of tubular members (33,34) that are to be secured to and between two sections (31,32) of an umbrella pole . (Page 1, last paragraph, lines 1 to 3; page 4, lines 3 to 10).

In addition, the tilt mechanism has a catch (40) that is mounted in one of the tubular members (33,34) and that projects into the other of the members to receive a locking pin (48) mounted in the other member. (Page 1, last paragraph, lines 3 to 5) Typically, the catch of the tilt mechanism is mounted in the tubular member which is secured to the upper section of an umbrella pole while the pin is mounted in the tubular member which is secured to the lower section of an umbrella pole. (Page 2, lines 9-11)

The catch (40) has a plurality of recesses (44) at an end projecting into the other tubular member. (Page 4, lines 17-18) The pin (48) is mounted in the other of the tubular members transversely of and in one of the recesses of the catch to lock the tubular

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members relative to each other. (Page 4, lines 26 to 29) At least one of pin (48) and the catch (40) are movable coaxially relative to each other to release the pin from a selected one of the recesses (44). (Page 1, last line to Page 2, line 2)

When one desires to change the orientation of the upper section 33 of an umbrella relative to the lower section 34, the pin 48 is grasped by the thumb and index finger of the user and pushed downwardly in the embodiment of Figs. 1 to 3. This retracts the pin 48 from within the centrally disposed recess 44 of the catch 40. The upper section of the umbrella may then be manually tilted in one direction or the other until the stem 42 of the catch 40 abuts the inside of the lower section 34 preventing further movement. At this time, the pin 48 moves into the now-aligned offset recess 44 in the stem 42. This locks the tubular sections 33, 34 relative to each other and the upper and lower sections of the umbrella relative to each other. (Page 5, penultimate paragraph).

Independent claim 5

Independent claim 5 is of similar scope to claim 1 but requires the pin (48) to be slidably mounted in a tubular member and to be movable away from the catch (40).

Independent claim 9

Independent claim 9 is of similar scope to claim 1 but requires the catch (40) to have a stem (42) that projects into and is pivotally secured to the other tubular member and that has the recesses (44) therein.

GROUND OF REJECTION TO BE REVIEWED ON APPEAL

Whether claims 1, 3 –9 and 11-14 fail to comply with the enablement requirement of 35 U.S.C. § 112, first paragraph.

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ARGUMENT

I. Claims 1, 3 and 4 comply with the enablement requirements of 35 U.S.C. 112, first paragraph

The Supervisory Patent Examiner alleges (1) that the claim(s) contain subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention and (2) that there is no disclosure for both the pin 48 and the catch being movable or the catch being movable.

The Supervisory Patent Examiner has the initial burden of presenting by a preponderance of the evidence why a person skilled in the art would not recognize in an applicant's disclosure a description of the invention defined by the claims

A description as filed is presumed to be adequate, unless or until sufficient evidence or reasoning to the contrary has been presented by the examiner to rebut the presumption. See, e.g., *In re Marzocchi*, 439 F.2d 220, 224, 169 USPQ 367, 370 (CCPA 1971). The examiner, therefore, must have a reasonable basis to challenge the adequacy of the written description.

The examiner has the initial burden of presenting by a preponderance of evidence why a person skilled in the art would not recognize in an applicant's disclosure a description of the invention defined by the claims. *Wertheim*, 541 F.2d at 263, 191 USPQ at 97. In rejecting a claim, the examiner must set forth express findings of fact regarding the above analysis which support the lack of written description conclusion. These findings should:

(A) Identify the claim limitation at issue; and

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(B) Establish a *prima facie* case by providing reasons why a person skilled in the art at the time the application was filed would not have recognized that the inventor was in possession of the invention as claimed in view of the disclosure of the application as filed. A general allegation of "unpredictability in the art" is not a sufficient reason to support a rejection for lack of adequate written description.

There is a strong presumption that an adequate written description of the claimed invention is present in the specification as filed

The Examiner has the initial burden, after a thorough reading and evaluation of the content of the application, of presenting evidence or reasons why a person skilled in the art would not recognize that the written description of the invention provides support for the claims.¹ There is a strong presumption that an adequate written description of the claimed invention is present in the specification as filed, *Wertheim*, 541 F.2d at 262, 191 USPQ at 96.... **Consequently, rejection of an original claim for lack of written description should be rare.** The inquiry into whether the description requirement is met is a question of fact that must be determined on a case-by-case basis. See *In re Smith*, 458 F.2d 1389, 1395, 173 USPQ 679, 683 (CCPA 1972) ("Precisely how close [to the claimed invention] the description must come to comply with Sec. 112 must be left to case-by-case development."); *In re Wertheim*, 541 F.2d at 262, 191 USPQ at 96 (inquiry is primarily factual and depends on the nature of the invention and the amount of knowledge imparted to those skilled in the art by the disclosure).

¹ The rejection of the claims in question was first presented on October 5, 2004, two months after a Notice of Allowance was issued. Five prior Office Actions did not raise a rejection under 35 U.S.C. 112.

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The absence of definitions or details for well-established terms or procedures should not be the basis of a rejection under 35 U.S.C. 112, para. 1, for lack of adequate written description. (MPEP 2163, II, A,1)

The Supervisory Examiner has not produced an Affidavit pursuant to the provisions of 37 CFR 1.104 (d)(2) to support the rejection of the claims as requested

During a telephone interview on January 11, 2005, the undersigned attorney stated an intent to have the Supervisory Patent Examiner provide her Affidavit pursuant to the provisions of 37 CFR 1.104 (d)(2) to support the rejection of the claims. However, the Supervisory Patent Examiner stated an intent not to provide such an Affidavit.

A formal request was made in the Request for Reconsideration of the Final Rejection filed January 12, 2005 that the Supervisory Patent Examiner provide an Affidavit pursuant to 37 CFR 1.104 (d)(2) to support the allegation in the rejection of the claims that the rejected claims contain subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains to make and/or use the invention being claimed.

The Supervisory Examiner has ignored the request and has not provided an Affidavit pursuant to 37 CFR 1.104 (d)(2).

The inventor had possession of the claimed invention at the time of filing

To satisfy the written description requirement, a patent specification must describe the claimed invention in sufficient detail that one skilled in the art can reasonably conclude that the inventor had possession of the claimed invention. See, e.g., *Moba, B.V. v.*

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Diamond Automation, Inc., 325 F.3d 1306, 1319, 66 USPQ2d 1429, 1438 (Fed. Cir. 2003);
Vas-Cath, Inc. v. Mahurkar, 935 F.2d at 1563, 19 USPQ2d at 1116.

Original claim 1 of the application claimed a tilt mechanism for an umbrella comprising, inter alia, “a first tubular member. . . ; a second tubular member. . . ; a catch mounted in one of said members. . . having a plurality of recesses at an end. . and a pin mounted in said other of said tubular members transversely of and in one of said recesses of said catch. . .”. Dependent claim 2 further characterized the tilt mechanism in that “at least one of said pin and said catch are movable relative to each other to release said pin from a selective one of said recesses”.

It is patently clear that the applicant was in possession of the invention as recited in claims 1 and 2 wherein at least one of the catch and pin were movable relative to the other since this is stated in *haec verba*.

Original claim 2 clearly shows that the applicant considered as his invention that “at least one of said pin and said catch are movable relative to each other to release said pin from a selective one of said recesses”. Thus, original claim 2 provides evidence that the inventor was in possession of an embodiment wherein the catch is movable and the pin is fixed; and an embodiment wherein both the catch and the pin are movable.

Claim 1 is readable on the structure illustrated in the drawings and described in the specification

Original claim 2 (and present claim 1) is readable on the structure illustrated in the drawings and described in the specification. The illustrated tilt mechanism has a pair of tubular members (33,34), a catch (40) mounted in one tubular member (33) and projecting into the other member (34) and having recesses (44) and a pin (48) mounted in the other

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member (34). At least one of the pin (48) and the catch (40) is movable coaxially relative to the other in order to release the pin (48) from the catch (40). As illustrated, the pin (48) is movable while the catch (40) is fixed.

Simply stated, claim 1 is generic to (1) a structure as illustrated in Fig. 3 wherein the catch 40 is fixed and the pin 48 is movable, (2) a structure wherein the catch 40 is movable within the tubular element 33 and the pin 48 is fixed in the tubular member 34 (such is merely a reversal of parts well within the skill of the art) and (3) a structure wherein each of the catch 40 and pin 48 is movable.

The applicant teaches that the pin (48) may be fixed and the catch (40) movable

Original claim 2 which has been incorporated into claim 1 clearly teaches one skilled in the art that the inventor had possession of the claimed invention, namely that (1) the catch 40 may be fixed and the pin 48 movable; or (2) that the catch 40 may be movable and the pin 48 fixed; or (3) that both of the catch 40 and the pin 48 may be movable within the scope of the invention intended and claimed by the inventor.

If a skilled artisan would have understood the inventor to be in possession of the claimed invention at the time of filing, even if every nuance of the claims is not explicitly described in the specification, then the adequate description requirement is met. See, e.g., *Vas-Cath*, 935 F.2d at 1563, 19 USPQ2d at 1116; *Martin v. Johnson*, 454 F.2d 746, 751, 172 USPQ 391, 395 (CCPA 1972) (stating "the description need not be in *ipsis verbis* [i.e., "in the same words"] to be sufficient").

In view of the above, a rejection of claims 1, 3 and 4 is not warranted under the provisions of 35 U.S.C. 112, first paragraph.

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**II. Claims 5 to 8 comply with
the enablement requirements
of 35 U.S.C. 112, first paragraph**

Independent claim 5 is specifically directed to the embodiment illustrated, for example in Figs. 2 and 3, wherein the pin 48 is movable.

Claim 5 requires "a catch mounted in one of said members. . . and a pin slidably mounted in the other of said tubular members. . . said pin being movable coaxially away from said catch. . . "(emphasis added). The rejection of claim 5 is particularly perplexing since the undersigned discussed this claim during the interview of January 11, 2005 and requested clarification of the rejection in the Request for Reconsideration of the Final Rejection filed January 12, 2005. No clarification of this rejection has been made by the Supervisory Examiner.

The alleged basis for rejecting claim 1, i.e. that there is no disclosure for both the pin 48 and the catch being movable or the catch being movable, does not apply to claim 5. The invention claimed in claim 5 is clearly described in the specification and the Supervisory Examiner has not given any reasons to the contrary.

In view of the above reasons and the reasons with respect to claim 1, a rejection of claims 5 to 8 is not warranted under the provisions of 35 U.S.C. 112, first paragraph.

**III. Claims 9 and 11 to 14 comply with
the enablement requirements
of 35 U.S.C. 112, first paragraph**

Independent claim 9 is specifically directed to the embodiment illustrated, for example in Figs. 2 and 3, wherein the catch 40 is fixedly mounted.

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Claim 9 requires "a catch **fixedly mounted** in one of said members. . . and a pin mounted in the other of said tubular members. .(emphasis added).

The alleged basis for rejecting claim 1, i.e. that there is no disclosure for both the pin 48 and the catch being movable or the catch being movable, does not apply to claim 9.

The invention claimed in claim 9 is clearly described in the specification and the Supervisory Examiner has not given any reasons to the contrary.

Claim 13 which depends from claim 9 specifically requires the pin to be slidably mounted to move away from the fixedly mounted catch.

In view of the above reasons and the reasons with respect to claim 1, a rejection of claims 9 and 11 to 14 is not warranted under the provisions of 35 U.S.C. 112, first paragraph.

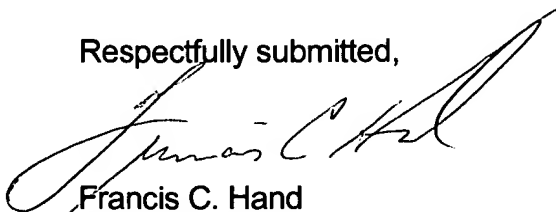
SUMMARY

For the reasons set forth above, the Final Rejection of claims 1, 3 to 9 and 11 to 14 should be reversed.

Since this application was withdrawn for issue by a notice of August 17, 2004 over the signature of John J. Love, Director, the request for Reconsideration of the Final Rejection requested that this application be re-submitted to John J. Love, Director for review. To date, the request has been ignored.

The application is believed to be in condition for allowance and such is respectfully requested.

Respectfully submitted,



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APPENDIX

1. A tilt mechanism for an umbrella comprising
 - a first tubular member for securement to a first section of an umbrella pole;
 - a second tubular member for securement to a second section of an umbrella pole;
 - a catch mounted in one of said members and projecting into the other of said members, said catch having a plurality of recesses at an end projecting into said other tubular member; and
 - a pin mounted in said other of said tubular members transversely of and in one of said recesses of said catch to lock said tubular members relative to each other, at least one of said pin and said catch being movable coaxially relative to each other to release said pin from a selected one of said recesses.
3. A tilt mechanism as set forth in claim 1 which further comprises spring means in said other tubular member for biasing said pin towards said catch.
4. A tilt mechanism as set forth in claim 3 wherein said spring means includes a coil spring abutting said pin and a plate secured in said other of said tubular members and abutting said coil spring.
5. A tilt mechanism for an umbrella comprising
 - a first tubular member for securement to a first section of an umbrella pole;
 - a second tubular member for securement to a second section of an umbrella pole;

a catch mounted in one of said members and projecting into the other of said members, said catch having a plurality of recesses at an end projecting into said other tubular member; and

a pin slidably mounted in said other of said tubular members transversely of and in one of said recesses of said catch to lock said tubular members relative to each other, said pin being movable away from said catch to allow said other tubular member to tilt relative to said one tubular member.

6. A tilt mechanism as set forth in claim 5 wherein said end of said catch is spaced concentrically from second tubular member with said tubular members in alignment with each other and is in abutment with said second tubular member in a terminal tilted position of said tubular members relative to each other.
7. A tilt mechanism as set forth in claim 6 wherein said tubular members have contoured interfitting end surfaces to define a smooth cylindrical contour therebetween with said tubular members in alignment with each other.
8. A tilt mechanism as set forth in claim 5 wherein said other of said tubular members has a pair of oppositely disposed elongated slots and said pin projects through said slots for grasping thereof.
9. A tilt mechanism for an umbrella comprising

a first tubular member for securement to a first section of an umbrella pole;

a second tubular member for securement to a second section of an umbrella pole;

a catch fixedly mounted in one of said members along a longitudinal axis and having a stem projecting into and pivotally secured to the other of said

members to allow said members to pivot relative to each other, said stem having a plurality of recesses at an end thereof; and

a pin mounted in said other of said tubular members transversely of a longitudinal axis of said other of said tubular members and in one of said recesses of said catch to lock said tubular members relative to each other, at least one of said pin and said catch being movable coaxially relative to each other to release said pin from a selected one of said recesses.

11. A tilt mechanism as set forth in claim 9 which further comprises spring means in said other tubular member for biasing said pin towards said catch.
12. A tilt mechanism as set forth in claim 11 wherein said spring means includes a coil spring abutting said pin and a plate secured in said other of said tubular members and abutting said coil spring.
13. A tilt mechanism as set forth in claim 9 wherein said pin is slidably mounted in said other of said tubular members to move away from said catch to allow said other tubular member to tilt relative to said one tubular member.
14. A tilt mechanism as set forth in claim 13 wherein said pin has a rounded head at each end projecting from said other tubular member for manual contact thereof.